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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/787,549	03/20/2001	Tomohiro Nagata	001560-392	2540
21839	7590	08/23/2004	EXAMINER	
BURNS DOANE SWECKER & MATHIS L L P POST OFFICE BOX 1404 ALEXANDRIA, VA 22313-1404			ELISCA, PIERRE E	
			ART UNIT	PAPER NUMBER

3621

DATE MAILED: 08/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/787,549

Applicant(s)

NAGATA ET AL.

Examiner

Pierre E. Elisca

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 03 August 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 15-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13, 15 and 16 is/are rejected.
- 7) ☒ Claim(s) 17 and 18 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. This Office action is in response to Applicant's RCE, filed on 08/03/2004.
2. Claims 1-13 and 15-18 are pending.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 1-13 and 15-18 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Collart (U.S. Pat. No. 6,405,203) in view of Fukushima et al. (U.S. Pat. No. 6,185,321).**

**As per claims 1, 12, 13 and 15 Collart** substantially discloses a system/method, and article of manufacture for tracking the distribution of content electronically, comprising:

provided in a product distribution environment where products, in the form of digital content, are distributed through electronic transmission between a product provider comprising at least one of a copyright owner creating a product and a distributor distributing the product, and a product user receiving the product from the product

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provider, for exchanging copyright information relating to the product through the communications lines with both of the product provider and the product user (see., abstract, col 4, lines 28-38, col 6, lines 1-63, specifically distributor, retailer and consumer, figs 1 and 2);

the copyright information management center centrally managing all copyright information existing in the product distribution environment through the electronic transmission by preregistering copyright information relating to the individual products to be finally provided to the product user in the center (see., abstract, fig 1, col 40, lines 11-22, specifically wherein it is stated that registered users who accepted the software license agreement).

Collart fails to explicitly disclose Applicant's newly added limitation wherein said product provider information and product information is available for retrieval by the product user at a time beginning prior to receiving the product in a final form (which is readable as pre-registered copy or data prior to receiving the product). However, Fukushima discloses a digital copying machine in which copy-prohibited image has been pre-registered (see., abstract, col 23, lines 32-67). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the electronic storage medium of Collart by including the limitation detailed above as taught by Fukushima because this would determine if the copy data as received via the electronic transmission are prohibited to be copied.

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As per claims 2, 8, 9, 10, 11 and 16 Collart discloses the claimed limitations of providing with a digital watermark embedding means by which at least one of the copyright owner and the distributor can embed copyright information relating to a product as digital watermark information directly in the data forming the product (see., col 31, lines 16-51, specifically wherein it is stated that watermarking enables identification and tracing of different copies of video data, col 33, lines 10-20, specifically watermarking which uniquely identifies each receiver of the signal).

As per claims 3, 4, 5, 6, and 7 Collart discloses the claimed limitations of providing with a digital watermark detection means for detecting the digital watermark information by the product provider and product user see., col 31, lines 16-51, specifically wherein it is stated that watermarking enables identification and tracing of different copies of video data, and detecting means see., col 32, lines 41-61, specifically watermark, if applied to individual copies of the video, may also be used to identify or detecting of the receiver of the copy, fig 5, item 550).

***Allowable Subject Matter***

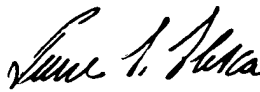
5. Claims 17 and 18 are allowed.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pierre E. Elisca whose telephone number is 703 305-3987. The examiner can normally be reached on 6:30 to 5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703 305-9769. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Pierre Eddy Elisca

Primary patent Examiner

August 19, 2004